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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,308	11/13/2001	Naoto Kataoka	81800.0172	5046

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HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER

PATTERSON, RASHAN OMAR

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,308

Applicant(s)

KATAOKA, NAOTO

Examiner

Rashan O. Patterson

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


TWYLER LAMB
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-16-04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 3, 4, 16, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Morikawa (US 6041165).

With regards to claims 1 and 16 Morikawa discloses a communication terminal

device with both-side receiving function comprising:

A recording unit (copy machine 1) capable of carrying out both side recording (Col. 4 lines 41-47); an image memory (memory unit 30) for storing an image (Col. 3 lines 58-60); and a control unit (100) for performing control by first control mode in which a received image is stored in the memory, and when images of two pages that are in relationship of a front page and a back page are stored in the image memory, the images of the two pages are recorded on both sides of a sheet by the recording units (Col 13 lines 62-66; Col 6 lines 4-6, lines 12-14).

With regards to claims 2 and 17 Morikawa discloses wherein the control controls recording and outputting order, and when images of the two pages that should be recorded next time in accordance with the recording and outputting order are stored in the image memory the control unit makes the recording unit record the images of two pages that should be recorded next time on both sides of a sheet (Col 6 lines 28-46; Col. 13 lines 62-66).

With regards to claims 3, 4 and 18 Morikawa discloses wherein the control unit possessing a second control mode in which both-side recording is started after receiving of images of all pages has been completed, and the control unit carried out either the first control mode or the second control mode (Col. 6 lines 4-6, lines 12-14).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2622

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (US 6041165) in view of Shibaki et al. (US 5724490)

Regarding claims 5, and 6 Morikawa does not teach the communication terminal device wherein the control unit performs control such that when free space in the image memory is more than a predetermined amount, the control unit selects the second control mode, and when the free space in the image memory is not more than the predetermined amount, the control unit selects the first control mode

Shibaki et al. discloses the communication terminal device wherein the control unit performs control such that when free space in the image memory is more than a predetermined amount, the control unit selects the second control mode, and when the free space in the image memory is not more than the predetermined amount, the control unit selects the first control mode (Col. 8 lines 10-26).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Shibaki et al. to have a communication terminal device where in the control unit performs control such that when free space in the image memory is more than a predetermined amount, the control unit selects the second control mode, and when the free space in the image memory is not more than the predetermined amount, the control unit selects the first control mode as in Col. 8 lines 10-26.

6. Claims 7, 8, 9 and 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (US 6041165) in view of Katsumasa (JP 05162008).

Regarding claims 7 and 8 Morikawa does not teach a communication device where in the second control mode, when a page corresponding to one of images to be recorded on both sides of a sheet does not exist, the other of the images is recorded on one side of the sheet without recording the one of the images

Katsumasa discloses a communication device where in the second control mode, when a page corresponding to one of images to be recorded on both sides of a sheet does not exist, the other of the images is recorded on one side of the sheet without recording the one of the images (Abstract).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Katsumasa to have a communication device where in the second control mode, when a page corresponding to one of images to be recorded on both sides of a sheet does not exist, the other of the images is recorded on one side of the sheet without recording the one of the images as in the abstract.

Regarding claims 9 and 10 Morikawa does not teach a communication terminal device according wherein in the second control mode, when a page corresponding to one of images to be recorded on both sides of a sheet does not exist, a blank image is recorded on one side of the sheet, said one side having no corresponding page

Katsumasa discloses a communication terminal device wherein in the second control mode, when a page corresponding to one of images to be recorded on both sides of a sheet does not exist, a blank image is recorded on one side of the sheet, said one side having no corresponding page (Abstract).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Katsumasa to have a communication terminal device wherein in the second control mode, when a page corresponding to one of images to be recorded on both sides of a sheet does not exist, a blank image is recorded on one side of the sheet, said one side having no corresponding page as in the abstract.

Regarding claim method claim 20, Morikawa does not disclose the method wherein under the second control mode, when one of images of two pages that are in relationship of a front page and a back page does not exist, a blank image and the other of the images of the two pages are recorded on both sides of a sheet.

Katsumasa discloses the method wherein under the second control mode, when one of images of two pages that are in relationship of a front page and a back page does not exist, a blank image and the other of the images of the two pages are recorded on both sides of a sheet (Abstract).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Katsumasa to have the method wherein under the second control mode, when one of images of two pages that are in relationship of a front page and a back page does not exist, a blank image and the other of the images of the two pages are recorded on both sides of a sheet as in the abstract.

7. Claims 11, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (US 6041165) in view of Ikuo (JP 09352379).

Regarding claim 11 Morikawa does not disclose the communication terminal device further including receiving means for receiving an image, wherein the receiving means first receives images of front pages, and then receives images of back pages

Ikuo discloses the communication terminal device further including receiving means for receiving an image, wherein the receiving means first receives images of front pages, and then receives images of back pages (Abstract)

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Ikuo to have the communication terminal device further including receiving means for receiving an image, wherein the receiving means first receives images of front pages, and then receives images of back pages as in the abstract.

Regarding claim 12 Morikawa does not disclose the communication terminal device further including receiving means for receiving an image, wherein the receiving means receives images of a front page and a back page alternately

Ikuo discloses the communication terminal device further including receiving means for receiving an image, wherein the receiving means receives images of a front page and a back page alternately (Abstract).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Ikuo to have the communication terminal device further including receiving means for receiving an image, wherein the receiving means receives images of a front page and a back page alternately as in the abstract.

Regarding claim 15 Morikawa does not disclose the communication terminal device wherein the recording unit carries out both-side recording sheet by sheet such

that after the recording unit records one of the image of the two pages that are in relationship of the front and the back page on one side of the sheet, the recording unit reverses the sheet, and then records the other of the images of the two pages on the other side of the sheet.

Ikuro discloses the communication terminal device wherein the recording unit carries out both-side recording sheet by sheet such that after the recording unit records one of the image of the two pages that are in relationship of the front and the back page on one side of the sheet, the recording unit reverses the sheet, and then records the other of the images of the two pages on the other side of the sheet (Abstract).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Ikuro to have the communication terminal device wherein the recording unit carries out both-side recording sheet by sheet such that after the recording unit records one of the image of the two pages that are in relationship of the front and the back page on one side of the sheet, the recording unit reverses the sheet, and then records the other of the images of the two pages on the other side of the sheet as in the abstract.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (US 6041165) in view of Matsubara et al. (US 5920744).

Regarding claim 13 Morikawa does not disclose the communication terminal device wherein when images of two pages have been recorded on the both sides of the sheet, the images of the two pages are erased from the image memory

Matsubara discloses the communication terminal device wherein when images of

two pages have been recorded on the both sides of the sheet, the images of the two pages are erased from the image memory (Col. 6 lines 54-59).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Matsubara to have the communication terminal device wherein when images of two pages have been recorded on the both sides of the sheet, the images of the two pages are erased from the image memory as in Col. 6 lines 54-59.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (US 6041165) in view of Rikima (US 5918088).

Regarding claim 14 Morikawa does not disclose the communication terminal device further including receiving means for receiving an image, wherein when images that includes images of a different size document are transmitted to the communication terminal device, the receiving means receives images of a same size document together.

Rikima discloses the communication terminal device further including receiving means for receiving an image, wherein when images that includes images of a different size document are transmitted to the communication terminal device, the receiving means receives images of a same size document together (Col. 11 line 47 – Col. 13 line 9).

It would have been obvious at the time of the invention for one skilled in the art to modify Morikawa by Rikima to have the communication terminal device further including receiving means for receiving an image, wherein when images that includes images of a different size document are transmitted to the communication terminal

device, the receiving means receives images of a same size document together as in Col. 11 line 47 – Col. 13 line 9.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumagai (US 5519484) discloses a method and apparatus for images on both sides of a recording paper. Wada et al. (5568573) discloses and apparatus for simultaneously reading image data printed on both sides of a document. Kageyama (US 5943436) reveals a printing apparatus and double sided control method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rashan O. Patterson whose telephone number is 571-272-0597. The examiner can normally be reached on Mon - Fri 9am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ROP

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**TWYLER LAMB
PRIMARY EXAMINER**